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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,321	08/20/2003	Irina Travkina	CR50U-US	6649
60723	7590	10/02/2006	EXAMINER	
AVON PRODUCTS, INC. AVON PLACE SUFFERN, NY 10901			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/644,321	Applicant(s) TRAVKINA ET AL.	
	Examiner JYOTHSNA A. VENKAT Ph. D	Art Unit 1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/15/04 and 3/18/04</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1615

### **DETAILED ACTION**

Receipt is acknowledged of IDS file don 11/15/04. Claims 1-37 are pending in the application and the status of the application is as follows:

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2-3 and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-3 lacks antecedent basis with respect to “ other source amino acids ”. The expression “ other source amino acids” is without metes and bounds.

Claims 19-21 are identical to claims 15-17 (duplicate claims).

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-9, 23-26, 28 and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 6,264,933 ('933).

See examples 1-4. “Wheat protein hydrolysate” reads on the claimed keratin-conditioning agent. All other ingredients comprise mascara base. Since the base and keratin conditioning agent is same, the composition would be expected to have the claimed viscosity measured by

Brookfield Viscometer at 77° F. All the examples are drawn to “ mascara compositions” and all the examples has keratin-conditioning agent “ hydrolyzed vegetable protein” and therefore the compositions are also useful for increasing the resistance of hair fibers of eyelashes to breaking.

*Products of identical chemical composition can not have mutually exclusive properties.”*

*A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)*

Claims 1-4, 6-10, 23-26, 28 and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 6,274,131 (‘131).

See examples 1-2 and 6-8. “Wheat protein hydrolysate” reads on the claimed keratin-conditioning agent. Panthenol in example 8 reads on claimed “ emollient/moisturizing agent”. All other ingredients comprise mascara base. Since the base and keratin conditioning agent is same, the composition would be expected to have the claimed viscosity measured by Brookfield Viscometer at 77° F. All the examples are drawn to “ mascara compositions” and all the examples has keratin-conditioning agent “ hydrolyzed vegetable protein” and therefore the compositions are also useful for increasing the resistance of hair fibers of eyelashes to breaking.

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Claims 1-2, 6-10, 23-26, and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 5,053,221 ('221)

See examples 1-3. "Crosilk liquid and Crosilk" reads on the claimed keratin conditioning agent, which is silk amino acids and mixtures thereof". Panthenol in example 8 reads on claimed "emollient/moisturizing agent". All other ingredients comprise mascara base. Since the base and keratin conditioning agent is same, the composition would be expected to have the claimed viscosity measured by Brookfield Viscometer at 77° F. All the examples are drawn to "mascara compositions" and all the examples has keratin-conditioning agent "hydrolyzed vegetable protein" and therefore the compositions are also useful for increasing the resistance of hair fibers of eyelashes to breaking.

*Products of identical chemical composition can not have mutually exclusive properties."*

*A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)*

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, and 6-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,264,933 ('933) and 6,214,329 ('329).

Patent '933 as explained above. Patent '933 does not disclose in the examples limitations of claims 11-18, 27, and 29-31. Patent '933 teaches the claimed emollient/moisturizing agents. See col.6, lines 26-33 for the various oils. These include claimed grape seed oil, sesame oil, macadamia oil, avocado oil and jojoba oil. See col.7, lines 3-7 for the percentage of the non-volatile oil. See col.7, lines 10-68 for the waxes and the percentage of waxes that can be used. Patent '933 at col.8, lines 1-10 teach hydrogenated plant oils, which are wax-like materials. See examples 2-4, where patent teaches that the compositions are useful for curling eyelashes. Patent '933 does not teach the wax-like material, which is specifically claimed in claims 30-31. However patent '329 teaches mascara compositions using waxes at col.5, lines 15 through col.6, lines 1-5. Patent also teaches the claimed oils at col.8, lines 7-14 and at col.12, lines 1-5 teaches wax-like materials, which are rosin, shellac and derivatives thereof. Patent at col.13, lines 5-8 teaches as biologically active agents hydrolyzed wheat protein. This is also claimed in the instant application as conditioning agent. See col.13, lines 24-27, where patent teaches that the compositions are useful for lengthening, thickening, curling eyelashes and providing color to the eyelash.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '933 by adding oil to the compositions and adding waxes and wax-like materials expecting beneficial effect to the eyelashes. One of ordinary skill in the art would be motivated to add the oils, and wax-like materials to the compositions with the reasonable expectation of success that oils will provide moisturizing effect and wax-like materials has the additional advantage of providing to the eyelashes film forming properties and the eyelashes having the conditioning agent, film forming polymer (wax-like substance), moisturizing agent and waxes are useful for lengthening, curling, and thickening the eye lash. This is prima facie case of obviousness.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,264,933 ('933) and 6,214,329 ('329) as applied to claims 1-4 and 6-37 above, and further in view of Croda brochure, "2002 year in Review".

Patents '933 and '329 do not teach the limitation of claim 5 drawn to specific keratin conditioning agent. Specification at page 6 teaches that this compound is known as "Keravis" supplied by Croda. Croda brochure teaches at page 2 that "keravis" improves the structure of the damages hair and it has dual properties that plasticizes the hair by moisturizing from within and lubricates the outer hair to protect the cuticle.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '933 by adding oil to the compositions and adding waxes and wax-like materials and adding the specific keratin conditioning agent "Keravis" expecting beneficial effect to the eyelashes. One of ordinary skill in the art would be motivated to add "keravis" the oils, and wax-like materials to the compositions with the

reasonable expectation of success that “keravis” will strengthen the keratin fiber (eyelashes) by providing lubrication and moisturization and oils will provide additional moisturizing effect and wax-like materials has the additional advantage of providing to the eyelashes film forming properties and the eyelashes having the conditioning agent, film forming polymer (wax-like substance), moisturizing agent and waxes are useful for lengthening, curling, and thickening the eye lash. This is prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**JYOTHSNA A VENKAT Ph. D**




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**Primary Examiner  
Art Unit 1615**

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JYOTSNA VENKAT  
PRIMARY EXAMINER  
GROUP 1600/1610